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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
SHINJI MORIYAMA, ET AL. : EXAMINER: DOTE, J. L.
SERIAL NO: 10/815,650 :
FILED: APRIL 2, 2004 : GROUP ART UNIT: 1756
FOR: TONER FOR ELECTROSTATIC :
IMAGE DEVELOPMENT :

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

The following Reply Brief is in reply to the Examiner's Answer dated October 11, 2006 (Answer).

Applicants acknowledge the Examiner's correction of the statement of the rejection under Ground (A) (Answer at 4). However, this correction does not effect Applicants' arguments for patentability herein.

The remainder of this Reply Brief responds to the Response to Argument, beginning at page 16 of the Answer, to the extent this Response is not a repetition of the response at paragraph 10 of the Final Rejection, to which Applicants have already responded in the Appeal Brief.

The Examiner finds that the statements in the Moriyama Declaration are "merely conclusory and not supported by creditable evidence," that Applicants "[appear] to know how to obtain the Machida activated carbon average particle diameter of 4.5 μm from the commercial product used in Machida and how to make Machida's toner (1), and that

Applicants have not provided any evidence to show why the CV of Machida's activated carbon, "roughly, the width of distribution of particle diameters about the volume average particle size, D_{50} , cannot be determined once the Machida toner (1) is reproduced" (Answer at 18).

In reply, Appellants do **not** know how Machida's exemplified activated carbon is obtained. Applicants, as supported by the Moriyama Declaration, state that the commercial product apparently used by Machida has a substantially larger volume-based median particle size (D_{50}). As stated in paragraph 7 of the Moriyama Declaration, it is **presumed** that the commercial product used by Machida was pulverized (emphasis added). Note that Machida discloses pulverization to adjust the size of his toner as a whole (page 8, lines 16-20). How many ways can Applicants emphasize that it is impossible to calculate CV based on the disclosure in Machida?

In response to Applicants' argument in the Appeal Brief that the particle diameter of $5.59\text{ }\mu\text{m}$, as used in the Moriyama Declaration, is approximately $5\text{ }\mu\text{m}$, the Examiner finds that Applicants have not provided any evidence to show that Machida "intended the particle size of 'approximately $5\text{ }\mu\text{m}$ or less' [described at page 4, lines 5-7 of Machida] to include $5.59\text{ }\mu\text{m}$ " (Answer at 20-21).

In reply, the Examiner has provided no evidence that the term "approximately $5\text{ }\mu\text{m}$ " does **not** include $5.59\text{ }\mu\text{m}$. According to 35 U.S.C. § 102 ("A person shall be entitled to a patent unless . . ."), the burden is on the Examiner, not Applicants, to gauge what Machida intended by using the term "approximately." Machida tested no particle size above 4.5 and below $7.5\text{ }\mu\text{m}$.

The Examiner incorrectly finds that Applicants are "not relieved of their burden of distinguishing the claimed invention from Machida by Machida's silence as to the CV of its activated carbon powder" (Answer at 21).

In reply, Applicants have already explained that this burden is impossible, given the non-enabling disclosure in Machida with regard to CV.

In response to Applicants' argument in the Appeal Brief that it is not proper for the Examiner to equate qualitative expressions of results between the specification and the prior art to find that the results are quantitatively the same, that there is no indication that the respective standards of measurement for the present invention and Machida are the same, and that it is not proper for the Examiner to use Applicants' own comparative data, which is not prior art, against them, the Examiner finds that it is proper; for example, that Applicants have not explained why the Machida result of "no occurrence" of fogging cannot be equated or compared with the background fogging (BG) results of "low occurrences" disclosed in the present specification (Answer at 23-24).

In reply, the Examiner still has no answer to the argument that qualitative expressions of results cannot be relied on when there is no indication of any similarity in the respective standards of measurement. The Examiner simply states that a person of ordinary skill in the art "would have recognized that the results in Machida could be compared" with the results described in the specification herein, but the Examiner offers no evidence in support (Answer at 23). Indeed, the Examples in the specification herein and the Working Examples in Machida use different materials and different amounts thereof. Compare the ingredients of Working Example 1 or 2 in Machida (page 8, line 5ff) with Examples 1 and 2 herein (specification at page 18, lines 4-19). Note that the amount of charcoal powder in Examples 1 and 2 is 12 parts per 100 parts of total of Resin A and Resin B, while the amount of activated carbon in Working Examples 1 and 2 in Machida is 6 parts, and 5 parts, respectively, per 100 parts of resin. No reputable researcher could possibly attribute the results in Machida to a particular CV of the activated carbon used, even knowing the CV of the charcoal used herein.

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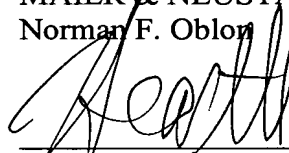
The Examiner finds that the description in the specification herein for evaluating thin-line reproducibility and Machida's description of fine line reproducibility are comparable (Answer at 24-25).

In reply, aside from the differences in respective ingredients and amounts thereof, and differences in the respective methodologies of evaluating the results, all this shows is that thin line reproducibility is good for Applicants' criteria, and fine line reproducibility is good for Machida's criteria, but it does not mean that the charcoal powder of Machida meets the presently-recited CV value.

Applicants continue to maintain that the all the rejections should be REVERSED.

Respectfully submitted,

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